

#### IV. REMARKS

##### Status of the Claims

Claims 1-6, 11, and 12, remain under consideration.

Claims 1-3 stand rejected under 35USC103(a) based on the cited reference King, et al, US Patent No. 6,011,554 in view of the reference Frederiksen, U.S. Patent No. 6,185,295. In addition claims 4 and 12 stand rejected under 35USC103(a) based on the cited reference King, et al. Claims 5,6 and 11, stand rejected under 35USC103(a) based on cited reference King, et al in view of the reference Schoeder, et al, U.S. Patent No. 5,797,098. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following arguments.

Applicant submits that the amendment to the abstract fully complies with the Examiner's rejection.

##### The Invention

With respect to claims 1-3, the cited art fails to teach a system that utilizes a predictive editor having a dedicated memory, where said predictive editor is used in conjunction with applications software also having a dedicated memory and further where the predictive editor and application software is controlled by a processor which automatically searches and copies words from the memory of the application software into the predictive editor memory.

With respect to claim 4 the cited references fail to disclose a predictive editor which is used in conjunction with a second editor application, the second editor usable for the purpose of amending the words obtained by the predictive editor.

Therefore, none of the cited references either alone or in combination teach the invention as described in independent claims 1 and 4.

#### Discussion of the Cited References

The Examiner acknowledges the deficiencies of the cited reference King et al. The reference King fails to disclose any processing means which is capable of automatically searching and copying words from the memory of an application software.

In order to remedy this deficiency the Examiner cites the reference Frederiksen. Frederiksen discloses a speed dial system which has a limited memory directly accessible for dialing of important numbers. The system of Frederiksen facilitates identifying a particular number as a speed dial candidate, nothing more. There is no mention of a predictive editor having a dictionary of words which can be supplemented by use of independent application memory. The Examiner's position appears to be that a memory used for any purpose will fill the gap in the disclosure of King et al. This is contrary to the intent and purpose of 35USC103(a). There is nothing in either King or Frederiksen which would encourage this combination.

The Examiner has also indicated that the reference King discloses an editor application for entering words but not to

amend them. This is an understatement as the editor function of King does nothing, but select or reject the results of the predictive editor function. To remedy this deficiency, the Examiner indicates that official notice is given that such managing operations for user defined lists were well known. Yet this statement remains unsupported by any reference.

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Since the cited references fail to support the rejection of the independent claims, the rejection of dependent claims also must fail. The above arguments are therefore equally applicable to the rejected dependent claims.

#### SUMMARY

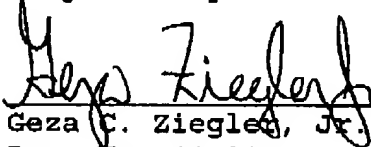
In view of the amendments to this application and the arguments stated above, Applicant submits that the claims under

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consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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